REMARKS

Claims 1-4 and 6-43 are pending in the application. Claims 1-4 and 6-43 stand rejected.

Applicants request further review and examination in view of the claimed amendments.

Claim Rejections – 35 USC § 102

Claim 15 stands rejected under 35 USC 102(e) as being anticipated by Enari (Pat. No. 6,747,998).

Claim 15 recites, "determining an external storage medium, the label being affixed to an external portion of the external storage medium." The Office states that this claim language is taught in the following manner: "Enari, Fig 11, bar-code printer 128 and bar-code reader 127." Official Action, at 3. Applicants disagree.

The Enari citation does teach a bar-code printer and a bar-code reader, and Enari as a whole does teach printing a bar code, attaching the printed bar code to a CD, and using a bar-code reader for reading the bar code attached to each CD (Enari, at col. 6, lines 18-22). However, Enari does not teach the claim language of "determining an external storage medium, the label being fixed to an external portion of the external storage medium (and the label corresponding to the record)." Aside from the bare depiction of a bar-code printer and bar-code reader in FIG. 11, and that mention at col. 6, lines 18-22, the only other mention Enari makes of a bar code is found at col. 6, lines 53-62:

> 3. The CD stock control server **121** stores the information
>   onto the hard disk **122**, then generates CD medium
> 55 management numbers in the order of acceptance, and
>   issues bar-code labels from the bar-code printer **128**.
> 4. The CD stock controller stores the CDs on a management
>   shelf in the order of the CD medium management num-
>   bers.
> 60 5. The CD user visits the reception desk of the information
>   management system **111**, then tells the CD medium man-
>   agement number, and thus can rent the CD.

As opposed to the claim language, which recites that the label corresponds to the record, this Enari citation teaches that a person ("the CD user") somehow has a management number for a CD and rents the CD by giving that management number to the reception desk. However that

person comes across the management number is not specified, and it is not specified that this management number corresponds to a record as is claimed.

Further, Applicants have amended claim 15 to recite, "the first label being based on a second label, the second label being stored on a storage portion of the external storage medium." This amended claim language is supported by the instant specification in at least paragraph [0068]. Applicants submit that Enari does not teach at least this amended claim language.

For at least these reasons, applicants submit that Enari fails to anticipate claim 15, as well as dependent claims 16-19.

Claim Rejections – 35 USC § 103

Claims 16-19 and 36-39 stand rejected under 35 USC 103(a) as being unpatentable over Enari in view of Koenck et al. (Pat. No. 6,748,122). Koenck fails to cure the defects of claim 15, as stated above. As such, Applicants submit that the cited combination of Enari in view of Koenck fails to render obvious claims 16-19 and 36-39.

Claims 1-4, 6-14, 20-35, and 40-43 stand rejected under 35 USC 103(a) as being unpatentable over Ottensen et al. (Pat. No. 6,222,697) in view of Sun et al. (Pat. No. 6,239,934) and further in view of Enari and further in view of Rothberg et al. (Pat. No. 6,412,083).

Claim 1 recites, "providing a command to generate the second label **based on the first label**," (emphasis added). The Office states that this claim language is taught in the following manner:

> The combination of Ottesen and Sun discloses the elements of the claimed invention as noted
>
> above but does not disclose providing a command to generate the second label based on the first
>
> label. Enari discloses providing a command to generate the second label [Enari, col 6, lines 15-

25, Fig 11, barcode printer 128]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include providing a command to generate the second label for the purpose of producing a bar-code label to be attached to an outside surface of the storage medium. The ordinarily skilled artisan would have been motivated to combine the teachings of Ottesen and Sun with the teaching of Enari because the above references disclose one or more bar-code labels for a storage medium.

Official Action, at 5-6. Applicants disagree.

Enari at col. 6, lines 15-25 discloses:

> Moreover, in the information source management system
> 15 111, three network printers 125-1 to 125-3, an image scanner
> 126, a bar-code reader 127, and four bar-code printers 128-1
> to 128-4 are provided. The network printers 125 are used for
> printing various forms. The bar-code printers 128 are used
> for printing bar codes to be attached to the managed CDs.
> 20 The bar-code reader 127 is used for reading the bar code
> attached to each CD. The image scanner 126 is used for
> entering music, lyrics and other information accompanying
> the CDs.
>   All the information related to the CDs is stored in the
> 25 database on the hard disk 122. CD stock control is carried
> out as follows.

The Enari citation does appear to teach printing bar codes and attaching those printed bar codes to CDs. However, claim 1 recites that a "second label [is] **based on the first label**," and the Enari citation does not teach a printed bar code based on a label. Further, in rejecting claim 1, the Office makes no assertion that this language is taught by the Ottesen or Sun citations.

Furthermore, Applicants disagree with the Office's stated motivation to combine the references. The Office states, "The ordinarily skilled artisan would have been motivated to combine the teachings of Ottesen and Sun with the teaching of Enari because the above references disclose one or more bar-code labels for a storage medium." Official Action, at 6. Ottesen does not teach a bar code, as the Office asserts, but teaches a form of data magnetically stored on a magnetic disk that Ottesen compares to a bar code:

> of the scrapped disk created or retained. Once a disk is
> determined to be acceptable, the disk is uniquely identified
> and a serial number or Disk Identification Number 60
> (DINUM) is recorded in one of the reserved areas of one
> side of the disk. The recording is made in a non-track
> specific manner, i.e., a magnetic pattern extending over a
> wide path in the selected reserved area. One example of such
> a recording pattern is a bar code type pattern which would 65
> extend across what might represent as many as 100 record-
> ing track widths. The recorded pattern not only provides

4

> uniquely identifying data but also a rotational orientation
> datum from which recording surface defects may be located.

Ottesen at col. 3, line 63-col. 4, line 2; and:

> It should be understood by those skilled in the art that the
> 15 described approach of recording the DINUM 30 into the
> reserved space 18 could include types of recording patterns
> of magnetic recording other than bar coding so long as the
> recording may be read by the head 34 of the disk drive 26
> and the DINUM 30 recording does not affect the servo
> 20 formatting and the read/write operations on the data region
> of the disk 10. One skilled in the art will further recognize

Ottesen at col. 8, lines 14-22. That is, Ottesen appears to teach magnetically storing a disk identifier (which it compares to a bar code) in a magnetic storage portion of a disk, and then reading this disk identifier with a disk drive. That is not a bar code as understood by one of skill in the art at the time of the present invention, nor is it a bar code as taught by Enari ("The bar-code printers 128 are used for printing bar codes to be **attached to the managed CDs**," Enari, at col. 6, lines 19-20, emphasis added) or Sun ("The cartridge may bear a cartridge bar code label 115," col. 5, line 47, where FIG. 7B-1 depicts bar code label 115 being affixed to an external portion of the cartridge).

Claim 1 also recites, "updating a database with an association between each file stored on the storage medium and a value associated with the first label." The Office states that this claim language is taught in the following manner:

The combination of Ottesen, Sun and Enari disclose the elements of the claimed invention as noted above but does not disclose updating a database with an association between each file stored on the storage medium. Rothberg disclose updating a database with an association between each file stored on the storage medium [Rothberg, col 5, lines 20-40, Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include updating a database with an association between each file stored on the storage medium as taught by Rothberg for the purpose of tracking the files on the storage medium by means of a directory [Rothberg, col 5, lines 20-40, Fig 3]. The ordinarily skilled artisan would have been motivated to combine Rothberg with the combination of Ottesen, Sun and Enari because Ottesen discloses a computer database of defects on a disk using the DINUM or Disk Identification Number [col 4, lines 1-10] and Rothberg discloses a directory of files on the disk [col 5, lines 20-40].

The combination of Ottesen, Sun, Enari and Rothberg discloses and a value associated with the first label [Ottesen, col 3, line 50 – col 4, line 10, col 5, lines 15-40].

Official Action, at 6-7. Applicants disagree.

Rothberg at col. 5, lines 20-40 teaches:

> At step **330**, if the file is not part of an OS component, [20]
> then the file may be a user data file or a user installed
> application file. In step **340** the user is informed that the file
> has a "defective sector." This may involve supplying the
> user with the name of the file containing the defective sector.
> At step **345**, the user is asked if the file can be deleted or if [25]
> the user wishes to restore the file from the user's backup. If
> the user determines that the file is not needed then, at step
> **350**, the host computer deletes the file from the directory and
> instructs the disk drive to write the "null" value to the logical
> address for the rescue-candidate location. The disk drive [30]
> performs the write and read verify operation described in the
> Off-Line Scan application to determine whether to allocate
> a spare addressable location (such as a spare sector) to the
> logical address. The host then proceeds to step **360** to check
> for additional rescue-candidate locations in the list. If the [35]
> user wishes to restore the file, then at step **355** the user is
> prompted to replace the file from the user's backup. After
> step **355**, the host computer goes to step **360** to check for
> additional rescue-candidate locations.
> We claim: [40]

The Rothberg citation appears not to teach, "updating a database with an association between each file stored on the storage medium," as is claimed, but rather removing from a directory a file that is **not stored** on a storage medium ("The host computer deletes the file from the directory and instructs the disk drive to write the 'null' value to the logical address for the rescue-candidate location," Rothberg at col. 5, lines 29-31). That is, the Rothberg citation appears to teach nearly the opposite of what is claimed.

For at least these reasons, Applicants submit that the cited combination of Ottensen in view of Sun and further in view of Enari and Rothberg fails to render obvious claim 1, or claims 20, 32, 33, 35, 40, 41, 42, or 43, which stand rejected for the same rationale. Further, Applicants submit that the cited combination of Ottensen in view of Sun and further in view of Enari and Rothberg fails to render obvious claims 2-4 and 6-14 (which depend from claim 1), and 21-34 (which depend from claim 20) for at least the reasons that the cited combination fails to render obvious their respective parent claims.

Claim 2 recites, "wherein the database is stored on a first device, further comprising: synchronizing the database with a second database stored on a second device." The Office states that this claim language is taught by Rothberg at col. 5, lines 20-40 and FIG. 3, and Enari at FIG. 11, element 127. Official Action, at 7. Applicants disagree.

Rothberg at col. 5, lines 20-40 is excerpted above, with respect to claim 1. Enari's FIG. 11 is excerpted herein below:
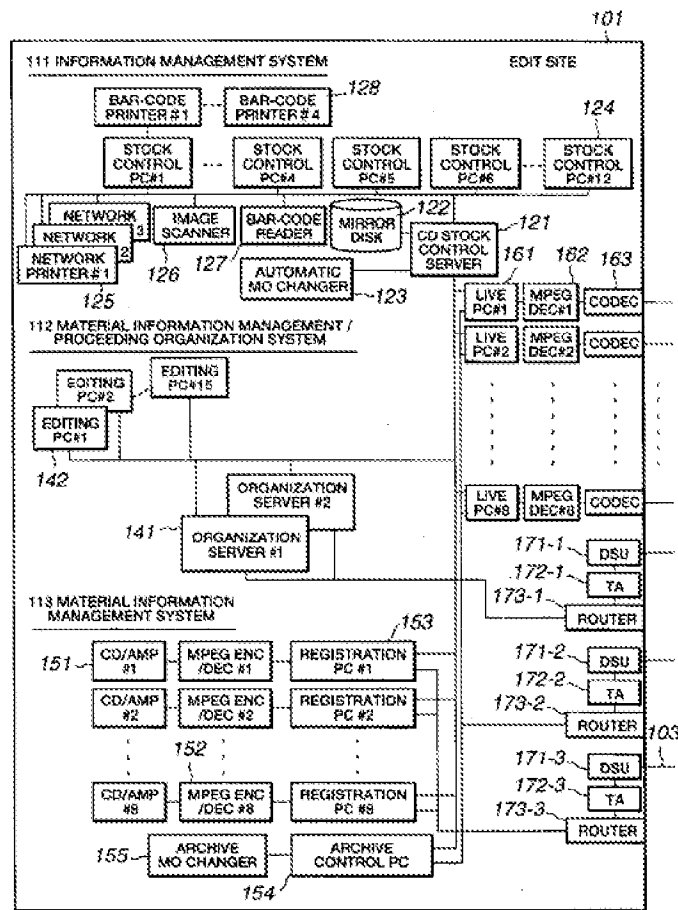
FIG.11

That is, Enari at FIG. 11, element 127 depicts a "bar-code reader."

Even if Rothberg teaches "the database," as claimed in claim 1, neither the Rothberg nor Enari citations teaches "a second database stored on a second device," as is claimed. The Rothberg citation teaches "the directory" – a single directory – and makes no indication as to the existence of other directories. Likewise, Enari's element 127 teaches not a second database, but a bar-code reader.

For at least these reasons, Applicants submit that the cited combination of Ottensen in view of Sun and further in view of Enari and Rothberg fails to render obvious claim 2, or claims 20 or 34, which stand rejected for the same rationale.

Claim 3 recites, "The method of claim 2 wherein the first device is a personal computer and the second device is a handheld device." The Office states that this claim language is taught by Rothberg at col. 5, lines 20-40 and FIG. 3, and Enari at FIG. 11, element 127. Official Action, at 7. Applicants disagree.

Rothberg at col. 5, lines 20-40 is excerpted above, with respect to claim 1, and Enari's FIG. 11 is depicted above, with respect to claim 2.

If the Rothberg citation teaches a database, it does not give any indication as to on what that database is stored, so it does not teach that the second device (upon which the second database is stored) is a handheld device, as is claimed. Likewise, Enari's element 127 depicts a bar-code reader, and if that bar-code reader is a handheld device, the Enari citation gives no indication that a database may be stored upon it.

For at least these reasons, Applicants submit that the cited combination of Ottensen in view of Sun and further in view of Enari and Rothberg fails to render obvious claim 3, or claim 22, which stands rejected for the same rationale.

Claim 7 recites, "determining the first label based on state information accessible to a device upon which the database is stored." The Office states that this claim language is taught by Ottesen at col. 3, line 50 – col. 4, line 10. Official Action, at 7. Applicants disagree.

Ottesen at col. 3, line 50 – col. 4, line 10 teaches:

SUMMARY OF THE INVENTION

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A recordable magnetic disk for use in a magnetic disk
drive is prepared using conventional disk fabrication, coat-
ing and curing techniques.

Thereafter, the disk is tested to determine defects in the
magnetic disk recordable surface coating and/or ascertain 55
the acceptability of the quality of the disk. If the defect level
of the disk is excessive, the disk is scrapped and no record
of the scrapped disk created or retained. Once a disk is
determined to be acceptable, the disk is uniquely identified
and a serial number or Disk Identification Number 60
(DINUM) is recorded in one of the reserved areas of one
side of the disk. The recording is made in a non-track
specific manner, i.e., a magnetic pattern extending over a
wide path in the selected reserved area. One example of such
a recording pattern is a bar code type pattern which would 65
extend across what might represent as many as 100 record-
ing track widths. The recorded pattern not only provides

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uniquely identifying data but also a rotational orientation
datum from which recording surface defects may be located.

Thereafter, the disk is selected and assembled with other
parts and disks from varied lots or batches into a disk drive.
5 The disk drive further is tested as a complete unit, and the
defect location data previously determined in disk drive
testing is retrieved from a computer data base using the
DINUM or Disk Identification Number.

Formatting of the disk surfaces of the disk drive for servo
10 control of the disk drive actuator is accomplished and

Thus, the Ottesen citation teaches uniquely identifying a disk with a serial number

("DINUM"), and the citation appears to teach how the DINUM may be applied to a disk, but the

citation does not appear to teach how the DINUM is calculated, past it possibly being related to

the disk being uniquely identified. In contrast, claim 7 does recite how the first label is

determined – determining the first label **based on state information accessible to a device**

upon which the database is stored – and this recitation is not found in the Ottesen citation.

For at least these reasons, Applicants submit that the cited combination of Ottesen in

view of Sun and further in view of Enari and Rothberg fails to render obvious claim 7, or claim

26, which stands rejected for the same rationale.

Claim 8 recites, "The method of claim 7 wherein the state information is a count sequence." The Office states that the language of claim 7 is taught by Ottesen at col. 3, line 50 – col. 4, line 10. Official Action, at 8. Applicants disagree.

Ottesen at col. 3, line 50 – col. 4, line 10 is excerpted above, with respect to claim 7. For reasons similar to those analyzed for claim 7 regarding the failure of Ottesen to teach state information accessible to a device upon which the database is stored, the Ottesen citation also fails to teach that the state information is a count sequence. That is, the Ottesen citation appears to teach uniquely identifying a disk with a serial number – but gives no indication as to how that serial number is calculated, including giving no indication as to it being calculated with a count sequence.

For at least these reasons, Applicants submit that the cited combination of Ottensen in view of Sun and further in view of Enari and Rothberg fails to render obvious claim 8, or claim 27, which stands rejected for the same rationale.

Claim 9 recites, "wherein the database includes records, each record including a first field having a value associated with the first label, and a second field having a value associated with a file stored on the storage medium." The Office states that this claim language is taught in the following manner:

Regarding claim 9, 28, the combination of Ottesen, Sun, Enari and Rothberg discloses the

elements of the claimed invention as noted above but does not disclose wherein the database

includes

records, each record including a first field having a value associated with the first label, and a

second field having a value associated with a file stored on the storage medium. However,

Rothberg discloses a directory of files stored on a storage medium [col 5, lines 20-40]. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the above combination of references to include wherein the database includes

records, each record including a first field having a value associated with the first label, and a

second field having a value associated with a file stored on the storage medium because creating

a table in a database is well-known and expected in the art.

Official Action, at 8. Applicants disagree.

It may be that creating a table in a database is well-known and expected in the art.
However, that is not what is claimed. What is claimed is a database populated with specific data
– the database includes records, each record including a first field having a value associated with
the first label, and a second field having a value associated with a file stored on the storage
medium. In rejecting claim 9, the Office has not given reasons why it would be obvious for one
of skill in the art at the time of the present invention to create a record including a first field
having a value associated with the first label, and a second field having a value associated with a
file stored on the storage medium, as is claimed.

For at least these reasons, Applicants submit that the cited combination of Ottensen in
view of Sun and further in view of Enari and Rothberg fails to render obvious claim 9, or claim
28, which stands rejected for the same rationale.

Claim 35 stands rejected for the same rationale that claim 1 stands rejected for. Official
Action, at 5-7. However, claim 35 makes wholly different recitations than claim 1. Claim 35
recites

> 35. An apparatus for matching file parameters with one or more external storage media, each of the one or more storage media having an associated label, the apparatus comprising:
>
> a user input device for accepting at least one search parameter from a set, the set comprising: file size, file author, and file type;
>
> a component configured to generate a query based on the accepted one or more search parameters;
>
> a component configured to a record returned in response to the query generated;
>
> a component configured to determine at least one label corresponding to the record; and
>
> a component configured to determine an external storage medium, the label being an affixed to an external portion of the storage medium.

and claim 1 recites:

> 1. A method for tracking files contained on a storage medium, the method comprising:
>
> determining that the storage medium has not been assigned a first label and a second label, the first label uniquely identifying the storage medium;
>
> writing the first label to a storage portion of the storage medium;
>
> providing a command to generate the second label based on the first label, the second label to be associated with an external portion of the storage medium;
>
> updating a database with an association between each file stored on the storage medium and a value associated with the first label; and
>
> in response to determining that a first file contained on the storage medium has been deleted, updating the database to reflect that the first file has been deleted.

For instance, in rejecting claim 35 using the same rationale for rejecting claim 1, the Office has not stated how the cited combination of references teaches claim 35's recitation of, "a user input device for accepting at least one search parameter from a set, the set comprising: file size, file author, and file type." Given that, Applicants submit that the Office has not established a *prima facie* case of obviousness for claim 35, as required by the MPEP.

CONCLUSION

For at least the foregoing reasons, Applicants request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

Date: August 11, 2010   /Peter Trahms-Neudorfer/

                                                         Peter Trahms-Neudorfer
                                                         Registration No. 59,282

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439